

Remarks

The Office action mailed June 29, 2006, has been reviewed and carefully considered. Claim 61 has been amended to incorporate the subject matter of claim 67, now canceled. New claims 79-80 have been added. Non-elected claims 52-56 and 70-78 have been canceled without prejudice toward filing a divisional application(s). Entry of these amendments is respectfully requested.

Claims 1-51, 57-66, 68, 69, 79 and 80 are now pending. The Office Action Summary indicated that only claims 61-69 are pending, but non-elected claims 1-51 and 57-60 have not been canceled.

Election/Restriction Requirement

Non-elected claims 1-51 and 57-60 have not been canceled. As indicated in applicants' May 4, 2006, Reply to PTO Communication, non-elected claims 1-51 and 57-60 have not been canceled because these claims should be rejoined when elected product claim 61 is found allowable (see MPEP §821.04).

35 U.S.C. §102 Rejections

Original claims 61, 63 and 66 were rejected under 35 U.S.C. §102(b) over Taylor or over Landymore et al. Claim 61 has now been amended to incorporate the subject matter of original claim 67, thus rendering the lack of novelty rejections over Taylor or Landymore et al. moot.

35 U.S.C. §103 Rejections

Original claims 67-69 were rejected under 35 U.S.C. §103 over Taylor or Landymore et al. combined with Pierpoint. In order to establish a *prima facie* case of obviousness, the prior art must suggest the desirability of making the asserted combination for arriving at the claimed invention (see MPEP §2143.01(I)). There is nothing in the relied-upon prior art suggesting the

desirability of including a balloon near the distal end of the catheter used in either Taylor or Landymore et al.

The devices in Taylor and Landymore et al. both penetrate the heart muscle. The catheters are used to introduce a therapeutic agent (Taylor) a diagnostic agent (Landymore et al.) directly into the heart muscle. The balloon at the tip of the catheter in Pierpoint is inflated to compress plaque or other obstructions in a coronary artery. However, there would have been no reason to insert an inflatable balloon directly into the heart muscle because the plaque or obstructions targeted by the catheter balloon of Pierpoint occur in coronary arteries rather than the heart muscle. Similarly, neither Taylor nor Landymore et al. suggest any reason for introducing an inflatable balloon directly into the heart muscle. Thus, there would have been no motivation to include such a catheter balloon in the device of Taylor or Landymore et al. Moreover, there is nothing in Taylor, Landymore et al. or Pierpoint suggesting the desirability of modifying a device to include a catheter balloon that can occlude a duct.

The Office action states that it would have been obvious to make the asserted modification to Taylor or Landymore et al. "to make an access device that could, during an operation, isolate an organ to reduce the risks of injury to the organ and surrounding tissue." However, none of the relied-upon references make any mention of how their devices isolate an organ to reduce the risks of injury to the organ. Thus, the source of motivation asserted in the Office action does not, in fact, exist in the prior art. Of course, such motivation must be found in the prior art to establish a *prima facie* case of obviousness.

In view of the foregoing, the obviousness rejection of original claims 67-69 must be reconsidered and withdrawn.

Claims 62 and 64-65 have been rejected under 35 U.S.C. §103 over Taylor or Landymore et al. combined with Parks et al. Parks et al. is relied upon for allegedly disclosing the features of claims 62 and 64-65. However, Parks et al. does not cure the above-noted fatal deficiencies relating the catheter balloon. Accordingly, the rejection of claims 62 and 64-65 must also be withdrawn.

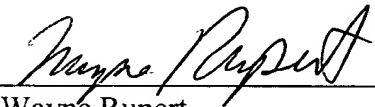
It is respectfully submitted that the application is condition for allowance. Should there be any questions regarding this application, examiner Stigell is invited to contact the undersigned attorney at the telephone number shown below.

Respectfully submitted,

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